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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,815	03/04/2004	Koichi Fujisawa	0754-0200P	3634
2292	7590	12/08/2005	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			BUTTNER, DAVID J	
			ART UNIT	PAPER NUMBER
			1712	
DATE MAILED: 12/08/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/791,815

Applicant(s)

FUJISAWA ET AL.

Examiner

David Buttner

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claims 1,4,5,8,9 and 13 rejected under 35 U.S.C. 103(a) as obvious over Fushihara 2002/0098919 in view of Bulpett 2002/0086743.

Fushihara exemplifies (table 3) two part urethane painted golf balls. Antioxidants can be included in the paint (paragraph 28). Note that comparison 3 includes the antioxidant Adekastab 260. This antioxidant is inherently a diphosphite (see ADK Product Literature; Fujii '559 col 9 line 22). Phosphonites are not named as possible antioxidants.

Bulpett (paragraph 118) names some phosphite and phosphonite antioxidants suitable for urethanes. The tetrakis(2,4-di tbutylphenyl) 4,4' biphenylene-diphosphonite named by Bulpett corresponds to applicant's preferred phosphonite (see formula 1 at page 7 of spec).

It would have been obvious to use a phosphonite as the stabilizer in Ohira's coating composition for the expected benefit.

Claims 1,4-8,10,11 and 13 rejected under 35 U.S.C. 103(a) as being unpatentable over Ohira '410 in view of Bulpett 2002/0086743 and Akashi '257.

Ohira claims golf ball coatings of urethane polyols and polyisocyanate. The coating can include antioxidants (col 5 line 51), but no species are named.

Bulpett (paragraph 118) names some phosphite and phosphonite antioxidants suitable for urethanes. The tetrakis(2,4-di t-butylphenyl) 4,4' biphenylene-diphosphonite named by Bulpett corresponds to applicant's preferred phosphonite (see formula 1 at page 7 of spec). Akashi discloses applicant's other preferred phosphonite is useful in polyurethanes (col 3 line 47) at 0.01-5% (col 6 line 24).

Art Unit: 1712

It would have been obvious to use a phosphonite as the stabilizer in Ohira's coating composition .

Claims 1,4,5,7,8 and 10-13 rejected under 35 U.S.C. 103(a) as being unpatentable over Kennedy '233 in view of Bulpett 2002/0086743 and Akashi '257.

Kennedy claims golf balls coated with urethanes. The coating can include antioxidants (col 3 line 2), but no species are named.

Bulpett (paragraph 118) names some phosphite and phosphonite antioxidants suitable for urethanes. The tetrakis(2,4-di tbutylphenyl) 4,4' biphenylene-diphosphonite named by Bulpett corresponds to applicant's preferred phosphonite (see formula 1 at page 7 of spec). Akashi discloses applicant's other preferred phosphonite is useful in polyurethanes (col 3 line 47) at 0.01-5% (col 6 line 24).

It would have been obvious to use a phosphonite as the stabilizer in Kennedy's coating composition.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Art Unit: 1712

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1,4-9 and 13 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-10 of copending Application No. 10-849231. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending application also claims (eg 2,8) painted one piece balls having a phosphonite in the paint.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicant's arguments filed 10/25/05 have been fully considered but they are not persuasive.

Applicant argues none of the references suggest phosphonites.

This is not convincing. Bulpett clearly names a phosphonite along with phosphates as possible antioxidants.

Applicant argues his specification shows unexpected improvements when including the phosphorous stabilizer.

Color stabilization is an expected result when including an antioxidant. Secondly, the showing is limited to a single species of phosphorous compound – not all hypophosphorous acid derivatives.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

Art Unit: 1712

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Buttner whose telephone number is 571-272-1084. The examiner can normally be reached on weekdays from 10 to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

Application/Control Number: 10/791,815

Page 6

Art Unit: 1712

you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David Buttner

DAVID J. BUTTNER
PRIMARY EXAMINER

12/5/05

David Buttner